

Application No.: 10/761,077

REMARKS

The following claims are pending in the application: 1 - 11

The following claims have been amended:

The following claims have been deleted: 6

The following claims have been added: 12 – 20

As a result of the foregoing Amendment, the following claims remain pending in the application: 1 – 5, 7 – 20.

Amendment to Claims 1 and 8

Applicant has amended claim 1, thereby changing the preamble from the open-ended "comprising" language to the narrower "consisting essentially of" language. Additionally, Applicant has incorporated the substance of claim 6 into amended claim 1 and has accordingly cancelled claim 6. Furthermore, Applicant has amended claim 8 to correct an obvious typographical error.

Newly Added Claims 12 – 20

Applicant has additionally added claims 12 – 20. Claim 12 is a combination of former claims 1 and 8 written with a "consisting essentially of" preamble. Claims 13 – 20 are based upon claims 2 – 5, 7, and 9 – 11. Accordingly, Applicant respectfully submits that no new matter was added in adding claims 12 – 20.

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The Objection to the Drawings

The Examiner has objected to the drawings as being either too dark (Figs. 1 – 4) or too light (Figs. 5 – 6) and requires new drawings in compliance with 37 CFR 1.121(d).

Applicant encloses herewith six replacement sheets in compliance with 37 CFR 1.121(d). Furthermore, Applicant has enclosed herewith a petition to file color drawings in accordance with 37 CFR 1.84. Additionally, Applicant has amended the specification in accordance with 1.84(a)(2)(iii). Accordingly, Applicant respectfully submits that the Examiner's outstanding rejection may be properly withdrawn.

The Rejection Under 35 U.S.C. §102(b)

The Examiner rejects claims 1, 3 - 4, 6, 8 and 10 under 35 U.S.C. §102(b) as being anticipated by Derwent Abstract No. 1993-271395. In so doing, the Examiner takes the position that: (1) since tetrahydrate is present, the composition is considered to be "aqueous", (2) the reference teaches a vanadates salt – ammonium metavanadate, (3) the Fe(II) chloride tetrahydrate is the supplemental metal anion, and (4) the sodium chloride is the substrate activator.

Applicant respectfully submits that in light of the amendment to claim 1 that the Examiner's outstanding rejection may be properly withdrawn as Derwent Abstract No. 1993-271395 fails to teach an aqueous solution as recited by claim 1. Claim 1 has been amended to an aqueous solution "consisting essentially of" the recited elements. Furthermore, Derwent fails to teach or suggest a metal anion, as alleged by the Examiner. Fe(II) chloride tetrahydrate dissociates in solution into an Fe²⁺ cation (ion with

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a positive charge) and two Cl^- anions (ions with negative charges). Accordingly, it cannot be fairly said that Fe(II) chloride tetrahydrate somehow provides a metal anion (that is, a metal having a negative charge). Accordingly, Applicant respectfully submits that the Examiner's outstanding rejection against claim 1, and those claims which depend therefrom (namely, 3 - 4, 6, 8 and 10), may be properly withdrawn as Derwent Abstract No. 1993-271395 fails to teach each and every limitation of the invention as presently claimed therein.

The Examiner rejects claims 1 - 4, 6, 8 and 10 - 11 under 35 U.S.C. §102(b) as being anticipated by Simon (US Pat. No. 4,036,667). In so doing, the Examiner takes the position that: (1) the sodium vanadate tetrahydrate component meets the film forming agent comprising a vanadate salt, (2) the sodium nitroferricyanide dehydrate component meets the supplemental soluble metal anion; and (3) that the potassium fluoride dehydrate component meets the substrate activator component.

Applicant has amended claim 1 and respectfully submits that in light thereof, the Examiner's outstanding rejection may be properly withdrawn as Simon fails to teach or suggest anything other than a hexavalent-chromium containing conversion coating. As noted above, claim 1 has been amended to an aqueous solution "consisting essentially of" the recited elements. As Simon fails to teach such a composition, it cannot be fairly said to anticipate the present invention as recited in claim 1, or in those claims which depend therefrom (namely, 2 - 4, 6, 8, 10 and 11). Accordingly, the Examiner's outstanding rejection may be properly withdrawn.

The Examiner rejects claims 1 - 4, 6, 8, and 10 - 11 under 35 U.S.C. §102(e) as being anticipated by Bengston et al. (US Pat. No. 6,692,583). In so doing, the Examiner

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takes the position that: (1) the source of vanadates ions meets the film forming agent, (2) the phosphorus material or the borate or boric acid material meets the supplemental soluble metal anion, and (3) the source of fluoride ions meets the substrate activator.

Applicant has amended claim 1 and respectfully submits that in light thereof, the Examiner's outstanding rejection may be properly withdrawn as Bengston fails to teach or suggest anything other than an acidic, phosphorus-containing conversion coating. As noted above, claim 1 has been amended to an aqueous solution "consisting essentially of" the recited elements. As Bengston fails to teach such a composition, it cannot be fairly said to anticipate the present invention as recited in claim 1, or those claims dependent therefrom (namely, 2 – 4, 6, 8, 10, and 11). Accordingly, the Examiner's outstanding rejection may be properly withdrawn.

The Examiner rejects claims 1 – 4, 6, 8, and 10 – 11 under 35 U.S.C. §102(e) as being anticipated by Marecic (US Pat. No. 6,468,364). In so doing, the Examiner takes the position that: (1) the ammonium vanadate meets the film forming agent, (2) the ammonium molybdates and/or the orthophosphoric acid meets the supplemental soluble metal anion, and (3) the sodium fluoride meets the substrate activator.

Applicant has amended claim 1 and respectfully submits that in light thereof, the Examiner's outstanding rejection may be properly withdrawn as Marecic fails to teach or suggest anything other than an acidic, phosphorus-containing conversion coating. As noted above, claim 1 has been amended to an aqueous solution "consisting essentially of" the recited elements. As Marecic fails to teach such a composition, it cannot be fairly said to anticipate the present invention as recited in claim 1, or those claims dependent

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therefrom (namely, 2 – 4, 6, 8, 10, and 11). Accordingly, the Examiner's outstanding rejection may be properly withdrawn.

The Rejection Under 35 U.S.C. §103(a)

The Examiner rejects claims 5, 7 and 9 under 35 U.S.C. §103(a) as being unpatentable over Bengston et al. (US Pat. No. 6,692,583) taking the position that one of ordinary skill in the art would consider the present invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness.

Applicant respectfully submits that in light of the amendment to claim 1, from which claims 5, 7, and 9 depend, that the Examiner's outstanding rejection may be properly withdrawn as the cited reference fails to teach each and every limitation of the invention as presently claimed. See also discussion of Bengston *supra*.

The Examiner rejects claims 5, 7 and 9 under 35 U.S.C. §103(a) as being unpatentable over Marcec (US Pat. No. 6,468,364) taking the position that one of ordinary skill in the art would consider the present invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness.

Applicant respectfully submits that in light of the amendment to claim 1, from which claims 5, 7, and 9 depend, that the Examiner's outstanding rejection may be properly

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withdrawn as the cited reference fails to teach each and every limitation of the invention as presently claimed. *See also* discussion of Marcec *supra*.

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CONCLUSION

In view of the foregoing amendment and accompanying remarks, the Applicant respectfully submits that the present application is properly in condition for allowance and may be passed to issuance upon payment of the appropriate fees.

Telephone inquiry to the undersigned in order to clarify or otherwise expedite prosecution of the subject application is respectfully encouraged.

Respectfully submitted,

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